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OFFICE OF PETITIONS

In re Application of
Sandanayaka et al.
Application No. 09/769,107
Filed: January 24, 2001
Attorney Docket No. WYTH0144-100

Decision on Petition

This is a decision on the petition filed July 21, 2005. The petition requests a refund of the extension of time fee and the Notice of Appeal fee paid April 25, 2005. The petition also requests the time period from January 7, 2005, until June 22, 2005, be considered Office delay for purposes of calculating any future Patent Term Adjustment.

The petition under 37 CFR 1.181 for a refund is **dismissed**.

The petition under 37 CFR 1.182 requesting at least 46 days be considered Office delay for purposes of Patent Term Adjustment calculations is **dismissed**.

Facts

A Final Office action was mailed October 25, 2004.

Petitioner filed a response in the form of an amendment on January 7, 2005.

As of April 25, 2005, petitioner had not received an Office action and chose to file a Notice of Appeal rather than risk the amendment not being entered and the application becoming abandoned. Petitioner also filed payment for a three month extension of time and the fee for a Notice of Appeal.

On June 22, 2005, the examiner mailed a non-final Office action which withdrew the finality of the prior action.

Petitioner contends the Notice of Appeal and fees would have been unnecessary if the Office had reviewed the amendment and withdrawn the finality of the Office action prior to April 25, 2005. Petitioner requests a refund of the fees.

Petitioner requests that the Patent Term adjustment calculation should reflect a minimum of 46 days of Office delay due to delay from January 7, 2005, until June 22, 2005.

The Refund Request

35 U.S.C. 41 states the Director "shall charge" certain fees. The language of the statute does not permit the Commissioner any discretion with respect to charging the fees set forth therein. The fees listed in 35 U.S.C. 41 include fees for petitions for extensions of time and fees for the filing of appeals.

A fee charged under 35 U.S.C. 41 may only be refunded upon compliance with 35 U.S.C. 42(d) which provides that, "The Commissioner may refund any fee paid by mistake or any amount paid

in excess of that required." The word "may", rather than "shall," in 35 U.S.C. 42(d) is permissive and indicates the Office has the discretion to refund, or not to refund, fees paid by mistake or in excess of that required.

The Office does not have the authority to refund the fee unless:
(1) the fee was paid by mistake, or
(2) the fee was paid in excess of that required.

Petitioner does not contend the fees were paid in excess of the amount fixed by statute. Therefore, the fees can only be refunded if petitioner proves the fees were paid by mistake.

Petitioner cannot obtain a refund by proving that an examiner made a mistake. The statute does not authorize refunds of fees based on prior mistakes by the Office. The statute requires a mistake in the actual payment of the fees by petitioner.

If an applicant intentionally pays a fee, the fee is not paid by mistake. For example, if an applicant files an application and submits the filing fee mistakenly believing the claims are allowable, the applicant will be unable to ask for a refund of all fees if the claims are rejected.

Petitioner did not accidentally or mistakenly submit the extension of time fee or notice of appeal fee. Petitioner intended to pay these fees.

The fact that the examiner withdrew the finality of the Office action does not transform an payment intentionally submitted to the Office into a payment made by mistake. At the time the fee was paid, petitioner intended to pay the fee and the fee was not submitted by mistake. An applicant may not pay a fee and then later determine it was not necessary and ask for a refund of the fee.

In Miessner v. United States, 97 App. D.C. 129, 1956 C.D. 30, 228 F.2d 643, 108 U.S.P.Q. 6 (1955), the Court of Appeals affirmed the Office's determination that applicant's payment of a fee had not been made by mistake. In Miessner, the Office had mailed a final rejection. In response, applicant filed a Notice of Appeal along with the required fee. On the same day applicant filed the appeal and fee, the examiner withdrew the final rejection and allowed the rejected claim. Applicant sought a refund of the appeal fee stating that the fee was paid by mistake since the appeal and fee had been unnecessary. The court stated, "Here the Commissioner decided – correctly, we think – the appeal fee was not paid by mistake."

If an applicant intends to pay a fee and a fee is owed, then the fee is not paid by mistake within the meaning of 35 U.S.C. 42(d). Petitioner intentionally paid the fees and the fees were properly accepted by the Office.

For the reasons above, the fees will not be refunded.

Patent Term Adjustment Request

The Office has not promulgated a rule providing for patent term adjustment determinations prior to the mailing of a Notice of Allowance. Therefore, the petition will be treated as a petition under 37 CFR 1.182.[1]

A petition under 37 CFR 1.182 will not be granted when the rules provide an avenue for obtaining the relief sought. In this case, petitioner can address the delay issue after the Office mails a Notice of Allowance.

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[1] The Office previously charged $130 for the petition. However, the fee for a petition under 37 CFR 1.182 is $400. Therefore, an additional $270 will be charged to petitioner's deposit account.

The petition will not be granted because it seeks to circumvent the requirements of 37 CFR 1.705. The Office intentionally chose not to create provisions allowing an applicant to address patent term adjustment calculations until after a Notice of Allowance is mailed.

During the adoption of 37 CFR 1.705, the Office addressed an argument alleging an applicant should be allowed to address patent term adjustment with the filing of an Office action.[2] The Office noted that an applicant's arguments would only be relevant if the patent term adjustment accruing as a result of such arguments survived reductions under 37 CFR 1.704(c)(1) through (c)(11). The parties cannot determine if the arguments will be relevant until a Notice of Allowance is mailed. "Thus, the Office is requiring that applicants not address patent term adjustment until the Office makes its initial patent term adjustment determination in the notice of allowance to avoid unnecessary expenditures of resources by applicants and the Office in preparing and handling submissions that turn out to be irrelevant."[3]

For the reasons above, relief under 37 CFR 1.182 will not be granted.

Telephone inquiries should be directed to Petitions Attorney Steven Brantley at (571) 272-3203.

Charles Steven Brantley
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Office of Petitions

[2] Comment 48, Changes to Implement Patent Term Adjustment Under Twenty-Year Patent Term; Final Rule, 65 Fed. Reg. 56,366, 53,388 (September 18, 2000), 1239 Off. Gaz. Pat. Office 14 (October 3, 2000).

[3] Response to Comment 48, Id.